

### REMARKS

This Amendment is responsive to the Office Action identified above, and is further responsive in any other manner indicated below.

### DEFECTIVE OFFICE ACTION - *BONA FIDE* RESPONSE

Applicant respectfully submits that the Office Action mailed 23 December 2003 is defective for the following reasons.

Claims 3/1, 16/14, 23/22 and 26/22 are not treated, discussed or even noted in either the statements of rejection or the comments of alleged support for such rejections. Further, while it appears that, in the third paragraph on page 7 of the Detailed Action, the rejection of Claim 25 is discussed, it is not known if such discussion is directed to Claim 25/21 or to Claim 25/22. As well, at Item 8 on page 13 of the Detailed Action, Claim 34 is rejected as being allegedly unpatentable over Iijima *et al.* "as applied to claim 31 above," and further in view of Kopetz. However, it is not known if such alleged rejection is directed toward Claim 34/31, or to either Claim 34/32 or 34/33. Therefore, the Action is defective in that the status of all pending claims is not given, and rejection of multiple dependent claims is incomplete throughout the comments. In an attempt to speedily further prosecution to a conclusion, and to preclude any delays on the part of the Office in completing and mailing a corrected Office Action, Applicant respectfully submits that the present is a *bona fide* attempt at a complete response to the 23 December 2003 Action, and that any deficiency in the completeness of this Amendment is unintentional, unavoidable, and/or beyond Applicant's ability to respond to the defective Action.

### **OBJECTION TO DRAWING CORRECTIONS - TRAVERSE**

On 15 November 1999, Applicant submitted "Proposed Amendments To The Drawings" with annotated FIGs. 1(a), 1(b), 6(a), 6(b), 9, 10, 13, 14(a), 14(b), 15, 16 and 21 attached thereto which contained proposed minor changes in the drawings for proper separate labeling of views and for correction of spelling errors. In the Preliminary Amendment filed concurrently on 15 November 1999, such changes were indicated as being the usual "proposed amendments to the drawings." No figures were added or deleted, no changes other than minor formatting and typographical corrections were made, and no new matter was added.

The proposed changes to properly label separate views in FIGs. 1, 6 and 14 were objected to for the reasons given at Item 1 on page 2 of the Office Action. Applicant respectfully regrets any confusion on the part of the Office, and reiterates that the changes proposed to FIGs. 1, 6 and 14 to separately label the views is merely proper US drawing format under 37 CFR §1.84. Therefore, Applicant respectfully requests that the objection to FIGs. 1, 6 and 14 be withdrawn.

### **REQUEST FOR ACKNOWLEDGMENT OF FORMAL DRAWINGS**

Attached hereto are seventeen (17) sheets of REPLACEMENT FORMAL DRAWINGS for all figures present in this case, *i.e.*, Figures 1(a), 1(b), 2-5, 6(a), 6(b), 7-13, 14(a), 14(b) and 15-21, which include the proposed corrections as shown in the annotated copies filed on 15 November 1999. Applicant respectfully requests approval and acknowledgment of the attached replacement formal drawings, and printing of the attached figures in any patent issuing hereon.

Moreover, the specification was objected to for the concerns listed at Item 1 on page 2 of the Detailed Action. The specification has been reviewed and amended to In view of the above amendments, Applicant respectfully requests reconsideration and withdrawal of the objection to the specification.

### **ABSTRACT OF THE DISCLOSURE - TRAVERSE**

The Abstract was objected to for the reasons give at Item 2 on page 2 of the Detailed Action. Applicant traverses the objection, since the Abstract was corrected at page 8 in the Preliminary Amendment filed 15 November 1999 to delete the paragraph break, which direction for amendment was proper at the time of filing of the Amendment under 37 CFR §1.72. To conform to present US patent practice, Applicant respectfully submits the Abstract on a separate page herein, with all changes indicated by strikethrough and underlining. Approval and entry of the attached Abstract are respectfully requested.

### **PENDING CLAIMS**

Claims 1-38 were pending in the application, under consideration and subject to examination at the time of the Office Action. Unrelated to any prior art, scope or rejection, appropriate Claims have been amended, added or deleted in order to adjust a clarity and/or focus of Applicant's claimed invention. That is, the amendments to the claims are unrelated to any prior art or scope adjustment, and are simply clarified claims in which Applicant is presently interested. At entry of this paper, Claims 39-67 are now pending in the application for consideration and examination.

### **REJECTIONS UNDER 35 USC §§102 AND 103 - TRAVERSED**

All 35 USC rejections (*i.e.*, the 35 USC §102 rejection of Claims 1-11, 14-17, 21, 23-27, 36 and 37 as being anticipated by Iijima *et al.* (US 5,760,698 A); the §103 rejection of Claims 12, 13, 18-20 and 28-30 as being unpatentable over Iijima *et al.* in view of Young (US 4,706,121 A); the §103 rejection of Claims 22, 32 and 33 over Iijima *et al.* in view of Yamauchi *et al.* (US 6,020,982 A); the §103 rejection of Claim 34 over Iijima *et al.* in view of Kopetz (US 4,866,606 A); the §103 rejection of Claim 35 over Iijima *et al.* in view of Kopetz, and further in view of Young; and the §103 rejection of Claim 38 over Iijima *et al.* in view of van Steenbrugge (US 5,502,436 A) are respectfully traversed, but the present cancellation of Claims prior claims 1-38 in favor of clarified replacement claims 39-67 (without prejudice or disclaimer of any scope or subject matter) has rendered such rejection and traversal arguments obsolete at this point in time. Based upon the following, reconsideration and withdrawal of the remaining rejections are respectfully requested.

All descriptions of Applicants disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed.

At the outset, as to the requirements to support a rejection under 35 USC §102, reference is made to the decision of *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 USC §102 required that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the

Court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is “inherent” in its disclosure. To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Moreover, the Court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

With regard to the requirements to support a rejection under 35 USC §103, reference is made to the decision *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under §103 to establish a *prima facie* case of obviousness, and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the Court, whether a particular combination might be “obvious to try” is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. As further noted by the Court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision in *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), wherein the Court, in reversing an obviousness rejection, indicated that deficiencies of the cited reference cannot be

remedied with conclusions about what is “basic knowledge” or “common knowledge.”

The Court pointed out:

The Examiner’s conclusory statements that “the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software” and that “another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial” do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of reference, simply to “[use] that which the inventor taught against its teacher.”...Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion. (emphasis added)

However, the cited prior art does not adequately support either a §102 anticipation-type rejection or a §103 obviousness-type rejection because it does not, at minimum, disclose (or suggest) the following limitations of Applicant’s clarified claims.

More particularly, the independent claims of Applicant’s clarified replacement claims all contain clarified components of sufficient detail, which are nowhere contained within the cited primary Iijima *et al.* reference. For example, clarified independent claim 39 contains the features/initiations of: a reservation data management section to manage data regarding timed reservation information; a time management section to give a notice when a time of a reserved operation arrives; and, a control section to transmit request information when the AV apparatus sets a timed reservation to be operated in cooperation with the secondary AV apparatus, where the request information requests the secondary AV apparatus to store

apparatus use information which constitutes at least a set of reservation data to manage at least one reservation including information of a desired time during which the secondary AV apparatus should operate.

The cited secondary references do not cure the deficiencies met with respect to the primary Iijima *et al.* reference.

As a result of all of the foregoing, it is respectfully submitted that the applied art would not support either a §102 anticipation-type rejection or a §103 obviousness-type rejection of Applicant's claims. Accordingly, reconsideration and withdrawal of such §§102 and 103 rejections, and express written allowance of all of the rejected claims, are respectfully requested.

#### **RESERVATION OF RIGHTS**

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

### EXAMINER INVITED TO TELEPHONE

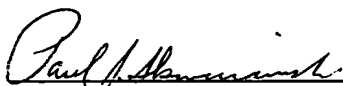
The Examiner is invited to telephone the undersigned at the local D.C. area telephone 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

### CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the claims listed above as presently being under consideration in the application are in condition for allowance. Accordingly, early allowance of such claims is respectfully requested.

This Amendment is being filed within the shortened statutory period for response set by the 23 December 2003 Office Action, and therefore, no Petition or extension fee is required. To whatever other extent is actually necessary, Applicant respectfully petitions the Commissioner for an extension of time under 37 CFR §1.136. No additional claims fees are required. Please charge any actual shortage in fees to ATS&K Deposit Account No. 01-2135 (as Case No. 501.37459X00).

Respectfully submitted,



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Paul J. Skwierawski, Registration No. 32,173  
ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 North Seventeenth Street, Suite 1800  
Arlington, Virginia 22209-3801, USA  
Telephone 703-312-6600  
Facsimile 703-312-6666

Attachments:  
Seventeen (17) Sheets  
REPLACEMENT FORMAL DRAWINGS